

REMARKS

The Office Action mailed March 23, 2007, has been received and reviewed. Claims 1-28 are currently pending in the application. Claims 1-28 stand rejected. Applicant has amended claim 23, and respectfully requests reconsideration of the application as presented herein.

Claim Rejections under 35 U.S.C. § 103

Claims 1-28 were rejected as being unpatentable over U.S. Pat. Pub. No. 2003/0017833 to Forrester (hereinafter “the Forrester reference”) in view of U.S. Patent 6,985,712 to Yamakawa et al (hereinafter “the Yamakawa reference”). This rejection is respectfully traversed. Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. **First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success.** Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. **The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.** *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-28 are improper because there is no motivation to combine the references or what is allegedly “well known.” The Examiner is respectfully reminded that there must be a **basis for combining or modifying references**. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (holding that “although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”).

Additionally, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teaching of the prior art so that the claimed invention is rendered obvious One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Furthermore, a prima facie case of obviousness may be rebutted by showing that the art, in any material respect, **teaches away from the claimed invention**. In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). Furthermore, it “is improper to combine references where the references teach away from their combination.” M.P.E.P. §2145(X)(D)(2) (citing In re Grasselli, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983)).

Regarding independent claim 1 and claims 2-21 depending therefrom, independent claim 22 and claims 23, 24 depending therefrom, independent claim 25 and claim 26 depending therefrom, and independent claims 27 and 28, Applicant’s independent claims include claim limitations not taught or suggested in the cited references. Furthermore, there is no teaching or suggestion to combine the references or what is alleged to be well known. Lastly, the references teach away from combining the references or what is alleged to be well known.

Applicant’s independent claims recite, in part:

1. A wireless device comprising: ... ***first section for transmitting at least two TDMA frequency bands***...(Emphasis added.)
22. A device ... comprising: ... ***first section for transmitting at least two TDMA frequency bands***...(Emphasis added.)
25. An apparatus comprising: ... ***transmit path for transmitting at least two TDMA frequency bands***...(Emphasis added.)
27. A wireless device comprising: ... ***first section for transmitting at least two TDMA frequency bands***...(Emphasis added.)
28. A method of operating a wireless device, comprising: ... ***transmit path for transmitting at least two TDMA frequency bands*** ...Emphasis added.)

Applicant respectfully asserts that neither the Forrester reference nor the Yamakawa reference, either individually or in any proper combination, teach or suggest Applicant’s invention as presently claimed in Applicant’s independent claims.

The Office Action alleges:

Regarding claims 1, 4-6, 9 and 18-19, ... *Forrester does not mention that the first wireless system is TDMA/GSM 900/1800 MHz (dual-band TDMA/GSM)*, the second wireless system is CDMA, and a single-pole-three-throw (SP3T) switch coupled to the first antenna, the first transmit/receive paths of the first wireless system, and the first transmit/receive paths of the second wireless system via a duplexer. Yamakawa suggest an antenna switch of a multi-band wireless device (See fig. 6) comprising a SP3T switch coupled to an antenna, transmit/receive paths of a TDMA band, and transmit/receive paths of a CDMA band via a duplexer for switching between TDMA and CDMA bands (See fig. 6 and col. 9 lines 28-45). Since Forrester does not suggest the wireless device is operable on multiple modes such as CDMA TDMA, PCS, and AMPS (See page 2 [0020]) and *dual-band TDMA/GSM is a well know telecommunication mode*; therefore, it would have been obvious to one skilled in the art to assign dual-band TDMA/GSM as the first wireless system and CDMA as the second wireless system as well as to use the antenna switch as suggested by the Yamakawa for the advantage of expanding the capability of the device to various communications modes as well as providing a proper antenna switch to the wireless device in accordance with its operation modes.

Claims 22-27 are rejected for the same reasons as set forth in claims 1, 4-6, 9 and 18-19.

Claim 28 is rejected for the same reasons as set forth in claim 1, as method. (Office Action, pp. 2-4; emphasis added).

The Forrester reference generally teaches or suggests receiving or reception configurations as opposed to transmission configurations. Specifically, the Forrester reference, as its title reads, teaches or suggests a “System and Method for Providing Auxiliary *Reception* in a Wireless Communications System”. (Emphasis added.) Accordingly, the Forrester reference does not teach or suggest a plurality of transmission frequency bands, but merely teaches or suggests that a “wireless communications device 100 can switch, for example, from receiving or transmitting CDMA signals to receiving or *transmitting TDMA signals* via the main antenna 110, for example, from CDMA to TDMA.” (Forrester, [0020]; emphasis added). While the Office Action concedes that “*Forrester does not mention that the first wireless system is TDMA/GSM 900/1800 MHz (dual-band TDMA/GSM)*”, the Forrester reference actually appears to teach away or suggest a *single band limitation for each of a cellular band and a PCS band*. (Office Action, p. 3; emphasis added). Specifically, the Forrester reference teaches or suggests, “... the main antenna 110 may be a dual band antenna tuned to receive and *to transmit cellular or PCS band* communications signals.” (Forrester, [0034]; emphasis added). While the “*cellular transmission chain of components [are] (not shown)* via a transmission port of the cellular duplexer 270”, the Forrester reference is clear about teaching or suggesting a single cellular (e.g., TDMA) band.

(Forrester, [0037]; emphasis added). Specifically, “[t]he cellular/PCS diplexer 250 passes ... *the cellular band* signals through the cellular diplexer 270 [] [v]ia the reception port of the cellular diplexer 270, the signal is amplified by the cellular LNA 290 before being filtered by *the cellular band filter* 310 (e.g., *an approximately 880 MHz band filter*).” (Forrester, [0039]; emphasis added). Clearly, the Forrester reference not only does **not** teach or suggest “*transmitting at least two TDMA frequency bands*” as claimed by Applicant, but the Forrester reference consistently teaches of only a single cellular (e.g., TDMA) band.

While the Office Action alleges that “dual-band TDMA/GSM is a well known telecommunication mode”, Applicant also respectfully reminds the Examiner that a “prima facie case of obviousness may be rebutted by showing that the art, in any material respect, **teaches away from the claimed invention.**” In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). Furthermore, it “is improper to combine references where the references teach away from their combination.” M.P.E.P. §2145(X)(D)(2) (citing In re Grasselli, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983)). Accordingly, Applicant respectfully asserts that the Forrester reference actually teach away from a “*first section for transmitting at least two TDMA frequency bands*” as claimed by Applicant in independent claims 1, 22, 27 and a “*transmit path for transmitting at least two TDMA frequency bands*” as claimed by Applicant in independent claims 25 and 27.

For these reasons, Applicant asserts that a 35 U.S.C. § 103 rejection of independent claims 1, 22, 25, 27 and 28 based on the Forrester reference in combination with the Yamakawa reference and the alleged well known “dual-band TDMA/GSM”, is improper and respectfully requests that the rejections be withdrawn.

The nonobviousness of independent claim 1 precludes a rejection of claims 2-21 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 1 and claims 2-21 which depend therefrom.

The nonobviousness of independent claim 22 precludes a rejection of claims 23 and 24 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also

MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 22 and claims 23 and 24 which depend therefrom.

The nonobviousness of independent claim 25 precludes a rejection of claim 26 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 25 and claim 26 which depends therefrom.

CONCLUSION

Claims 1-28 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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